REMARKS

The comments of the Examiner as set forth in the Office Paper mailed 27 November 2007 have been carefully studied and reviewed.

Claims 1-8, 9-23 and 25-32 are pending in the application.

Claims 1-8, 22, 23 and 25-32 have been withdrawn from consideration.

Claims 9-21 have been rejected.

Claims 9-21.

Claims 9-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over King (U.S. Pat. No. 3,198,776) and Sheridan (U.S. Pat. No. 3,677,808) in view of Sleeter (U.S. Pat. No. 6,277,310) and Song (U.S. Pat. No. 6,010,596) and optionally Borsinger et al. (U.S. Pat. App. No. 2006/0289138).

Borsinger et al. (U.S. Pat. App. No. 2006/0289138 A1, filed 3-17-2003) is alleged to be available as prior art under 35 U.S.C. §102(e) because

(1) the filing date for claims 9-21 of the present pending application is 10-9-03 and

(2) claims 9-21 are not entitled to the benefit of the filing date (10-10-02) of the provisional application filed 10-10-02.

Claims 9-21 are alleged not to be directed solely to the subject matter described and supported by the provisional application. The subject matter of heating to a temperature between approximately 200 degrees F to approximately 300 degrees F is alleged to have been first introduced in this application 10/682,283 and is not reasonably conveyed by provisional application 60/417,620.

In response, Applicants respectfully traverse this rejection because the Borsinger et al. provisional patent application is not an appropriate reference under 35 U.S.C. §102. The Borsinger et al. provisional patent application does share a common assignee as the present pending application

As the Examiner correctly stated, the filing date of US 2006/0289138 is 17 March 2003. The inventors are Gregory G. Borsinger and Abbas Hassan, and the application has been assigned to Marcus Oil and Chemical, Houston, Texas.

The inventors of the present application are Aziz Hassan and Gregory G. Borsinger, and the application has been assigned to HRD Corp., Houston, Texas.

Attached hereto is a Declaration Under Rule 1.132 from Mr. Aziz Hassan, one of the inventors of the present pending application, stating his role in HRD Corp., and the relationship between it and Marcus Oil & Chemical, such that they are the same inventive entity, and that, at the time both inventions were made, they were owned by or subject to an obligation of assignment to the same person.

Attached to Mr. Hassan's Declaration are a page from the Marcus Oil website, stating that HRD Corp. Is the abbreviation for Hassan Research and Development Corp., and that "HRD Corp. Is the parent Company of Marcus Oil & Chemical". Also attached to the Declaration is a letter from the Secretary of State, State of Texas, stating that Mr. Aziz Hassan and Mr. Abbas Hassan are corporate officers, Mr. Aziz Hassan being a Director and Secretary of HRD Corp, and Mr. Abbas Hassan being a Director and President of HRD. Corp., and that HRD Corp. uses the assumed name of Marcus Oil & Chemicals. Thus, for the purposes of assignment, at the time both the inventions (i.e., the present pending specification and the Borsinger et al. reference) were made, they were owned by or subject to an obligation of assignment to the same person.

Accordingly, the Borsinger et al;. reference must be withdrawn as a reference, and the claims rejected based on this improper reference must be reversed.

Second, Applicants maintain that the subject matter of claims 9-21 is supported by the specification of the Borsinger et al. provisional application 60/417620 filed 10 Oct. 2002.

For example, in Ex. 1 of the provisional application, p. 11, paragraph towards the page bottom, commencing with "Fifteen grams (15 gm)...." indicates that the wax, which according to Table 1 has a melting point ranging from 155-160 degrees F, was melted on a hot plate, and then mixed with boiling water, indicating that the temperature of the mixture exceeded 200 degrees F.

The subsequent paragraph (of the provisional application) starting on p. 11, 2 lines from the bottom and continuing through the end of Example 1 states the gypsum formulations were heated in an oven that was heated to 257 degrees F. Lines 1-2 on

page 13 of the provisional application indicate the samples were placed in an oven for one hour at a temperature of 200 degrees F.

In the present pending application, Example 1 starts on p. 25, line 28 and continues to p.28, line 4. The same temperatures discussed in the preceding paragraphs regarding the provisional application are contained within this Example (p. 26, lines 17-29; p. 27, lines 20-26), thereby providing support for the claimed temperatures.

Thus, it is apparent that the rejection of these claims based on 35 USC §102(e) is improper, that there is support for Claims 9-21 in the provisional application that is the priority document for the present pending application, and that the Borsinger et al. reference, U.S. Pat. App. No. 2006/0289138 A1 is an improper reference, and it is respectfully submitted that any rejections based on this improper reference must therefore be withdrawn.

The other rejections under 35 U.S.C. §103(a) have been maintained, for the reasons stated in the previous Office Action. In response, and assuming that emulsions are used in the particleboard and gypsum board industries as mentioned in Sheridan, the references still fail to teach the concentration of emulsion employed by the present method to achieve a water-resistant gypsum preparation. Accordingly, independent Claim 9 has been amended to incorporate the range of emulsion concentrations used to render gypsum board water resistant, based on the language of Claims 16 and 17. Claims 16 and 17 has been amended to eliminate duplicate claims. Recognizing the additional flexibility now available after the KSR decision (KSR International Co., v. Teleflex, Inc., 127 S.Ct. 1727 (2007), Applicants still maintain that without any type of teaching of emulsion concentration in any of the references, amended Claim 9 defines patentable subject matter, and should therefore be allowed.

Claims 10-13 have been cancelled.

Claim 14 has been amended so as not to depend from a cancelled claim.

Claims 16 and 17 have been cancelled because their language has been incorporated into amended Claim 9.

Claim 18 has been amended so as not to depend from a cancelled claim.

Claim 20 has been amended so as no to depend from a cancelled claim.

Claim 21 has been cancelled.

Thus, none of the references, either alone or in combination, teaches using a low iodine value hydrogenated wax as an emulsion to render gypsum water render a gypsum product water resistant as described by Applicant in these claims, Further, having distinguished independent Claim 9 from the prior art, as described in the previous section, applicant respectfully submits that the dependent Claims are similarly distinguished from, and patentable over, the prior art. and accordingly, these Claims define patentable subject matter. Applicant therefore respectfully submits that the rejections of these claims under 35 U.S.C. §103(a) must be withdrawn.

Conclusion

Applicant thanks the Examiner for his thoughtful review of this application, and respectfully requests the Examiner review the pending Claims and to find that they define patentable subject matter. Thus, it is respectfully requested that the present pending Claims be allowed.

In the event that this response does not place the application in condition for allowance, the Examiner is respectfully requested to telephone the undersigned in order that an attempt can be made to place the application in condition for allowance as expeditiously as possible.

Respectfully submitted,

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DATED: May 27 , 2008

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BSN7_AMD2_02_2008.wpd